

REMARKS

Upon entry of the present amendment, claims 1, 5, 7 and 8 will have been amended while claims 10-20 will have been submitted for consideration by the Examiner. In view of the herein contained remarks, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections together with an indication of the allowability of all of claims 1-20 pending herein. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants wish to respectfully thanks the Examiner for acknowledging their Claim of Foreign Priority under 35 U.S.C. § 119 as well as for confirming receipt of the certified copy of the foreign priority document upon which such claim is based.

Applicants further thank the Examiner for accepting the drawings filed on September 11, 2003, as well as for considering the documents cited in the Information Disclosure Statement filed on January 23, 2004 by the return of the signed and initialed PTO-1449 Form attached to the above-mentioned Information Disclosure Statement.

In the outstanding Official Action, the Examiner rejected claims 1, 4, 6 and 7 under 35 U.S.C. § 102(a) as being anticipated by LEMELSON (U.S. Patent No. 6,293,282). Claims 8 and 9 were rejected under 35 U.S.C. § 103(a) as unpatentable over LEMELSON in view of KOBAYASHI et al. (Japanese Patent Application JP 2002-233575).

Applicants respectfully traverse each of the above-noted rejections and submit that they are inappropriate and the disclosures thereof are inadequate to anticipate or even render unpatentable any of the claims pending in the present application.

Accordingly, reconsideration and withdrawal thereof is respectfully requested, in due course.

In the outstanding Official Action, the Examiner objected to claims 2, 3 and 5 as being dependent upon a rejected base claim. However, the Examiner noted that these claims would be allowable if rewritten into independent form including all of the limitations of the base claim and any intervening claims. Although Applicants note with appreciation the Examiner's indication of allowable subject matter in claims 2, 3 and 5, Applicants respectfully decline to rewrite these claims into independent form at the present time in view of the basis for patentability of independent claim 1 as will be set forth hereinafter below.

According to an exemplary embodiment disclosed in the present application, a magnetic anchor remote guidance system is set forth. In particular, the remote guidance system comprises an engagement member which engages with a body portion in a patient's body. A magnetic member, of a magnetic material, is connected to the engagement member. A magnetic anchor guide device which is disposed out of the patient's body and produces a magnetic field to power the magnetic anchor. Thus, the body portion engaged by the engagement member is raised by supplying power to the magnetic anchor via the magnetic field produced by the magnetic anchor guide device. It is respectfully submitted that the combination of features recited in Applicants claims is not taught, disclosed nor rendered obvious by either LEMELSON or even LEMELSON in combination with KOBAYASHI et al.

According to a feature of a disclosed embodiment of the present invention, the body portion engaged by the engagement member is raised by power supply to the

magnetic anchor via the magnetic field produced by the externally positioned guide device. At least this feature of Applicants invention, in the claimed combination, is not taught, disclosed nor rendered obvious by LEMELSON.

LEMELSON discloses a system and method for treating select tissue in a human being. As illustrated in Fig. 10, the LEMELSON device is configured to abrade tissue within blood vessels or other body ducts. The drive mechanism is inserted through the lumen of a catheter. In particular, a catheter 60 is provided with a rotary abrasion member mounted on a central axis and having an abrasive outer surface 115. Magnets are mounted on either or both ends of the cylindrical rotary abrasion member. In operation, after the catheter has been inserted and positioned, an intermittent or rotating external magnetic field is applied from electromagnets outside the patient's body. This field engages the magnets and turns the rotary abrasion member causing a mechanical abrasion of the surrounding tissue (column 22, lines 14-30).

Accordingly, no component of LEMELSON comprises an engagement member that is configured to raise a body portion by power supply to the magnetic anchor via a magnetic field. The rotary abrasion member 111 of LEMELSON is not an engagement member as recited in Applicants claim. In other words, while there may be momentary contact between various portions of the rotary abrasion member with tissue of the body, the abrasion member does not raise the body portion engaged by the engagement member as recited in Applicants claim 1.

Accordingly, for at least this reason, it is clear that claim 1 is clearly patentable over LEMELSON. Nor would it be obvious within the meaning of 35 U.S.C. § 103 to modify the device of LEMELSON to raise a body portion. There is absolutely no

teaching whatsoever within the various embodiments of LEMELSON for such modification.

KOBAYASHI et al. clearly does not supply the above-noted deficiencies of LEMELSON and thus even the combination of LEMELSON and KOBAYASHI et al. is inadequate and insufficient to render unpatentable any of the claims in the present application.

By the present Response, Applicants have submitted several additional claims for consideration by the Examiner. These claims are submitted to be patentable at least for the reasons set forth above as well as for reasons related to their respective recitations. In this regard, claim 19 is directed to a magnetic anchor apparatus including an engagement member which is configured to engage with and raise a body portion on the patient's body and a magnetic anchor comprising a magnetic material and connectable to the engagement member and being configured, upon supply of power, to lift the engagement member and the body portion engaged therewith. The combination of features recited in Applicants claim 19 is clearly not taught, disclosed nor rendered obvious by LEMELSON. LEMELSON does not disclose at least the engagement member as recited in claim 19 nor the magnetic anchor recited in claim 19.

Claim 20 is further submitted to be patentable over the features of the disclosure of LEMELSON. In this regard, claim 20 recites, inter alia, that the body portion engaged by the engagement member is raised by supplying power to the magnetic anchor via the magnetic field produced by the guide device so that the body portion is capable of being resected by a dissector which is distinct from the engagement

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member. It is respectfully submitted that at least this feature, in the claimed combination of claim 20, is not taught, disclosed nor rendered obvious by LEMELSON.

In view of the above, Applicants respectfully request reconsideration and withdrawal of each of the outstanding rejections together with an indication of the allowability of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have changed the dependency of claim 5, revised the language of several claims, and have submitted additional claims 10-20 for consideration.

Applicants have discussed the disclosure of the references relied upon and have pointed out the shortcomings and deficiencies thereof with respect to the present invention. Applicants have further discussed the recitations of the claims in the present application and have pointed out the shortcomings and deficiencies of the disclosure of the references with respect thereto. Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all the claims in the present application and respectfully request an indication to such effect in due course.

Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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